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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,788	01/21/2005	Stephane Rouchy	0512-1257	1959

466 7590 10/19/2005

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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT PAPER NUMBER

2687

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/521,788

Applicant(s)

ROUCHY ET AL.

Examiner

Marivelisse Santiago-Cordero

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 11-20 are pending. Claims 1-10 were cancelled.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The references cited in the Information Disclosure Statement (IDS) filed on 1/21/2005 have been considered.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "2" (page 3, line 30); "8" (page 3, line 37); and "10" (page 4, line 14). In addition, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "20". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing-sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed

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of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: the term “portable computer 8a” (page 5, lines 5-6) should be replaced with --portable computer 8e--.

Appropriate correction is required.

Claim Objections

6. Claim 12 is objected to because of the following informalities: the term “said information exchange means” should be corrected in order to be consistent with the terminology stated for claim 11 from which it depends, which states “means for exchanging information”. Appropriate correction is required.

7. Claims 19-20 are objected to because of the following informalities: the term “said information re-transmission device” (Claim 19, line 7) should be corrected in order to be consistent with the terminology stated in line 2 of the same claim, which states “a device for retransmitting information”. Appropriate correction is required.

8. Claim 20 is objected to because of the following informalities: the dependency of the claim should be corrected to claim 19. For purposes of applying prior art, the dependency of claim 20 will be treated as from claim 19 in order to be consistent throughout the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 11 and 18, the word "means" is preceded by the word(s) "automatic" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

11. Claim 18 contains the trademark/trade name BLUETOOTH. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a radio information transmission protocol and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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13. Claims 11-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Vanluijt et al. (hereinafter "Vanluijt"; Pub. No.: US 2002/0132614).

Regarding claim 11, Vanluijt discloses an information retransmission device (Fig. 1, reference numerals 120-122) comprising means (21) for exchanging information with a remote server (Fig. 1, reference numeral 101) via a switched telecommunications network (6) (Fig. 1, reference numeral 110; page 3, paragraph [0033]) and further comprising automatic means (23) for detecting the presence of a nearby output device (8) (Fig. 1, reference numeral 130; page 3, paragraph [0038]) and automatic means (23) for retransmitting information received from said remote server from said device (2) to an output device (8) that has been detected nearby (page 2, paragraph [0022]) and that is supplied with power by virtue of its connection to the telecommunications network and is integrated into an adapter (page 1, paragraphs [0011]-[0012]).

Regarding claim 12, Vanluijt discloses a device according to claim 11, wherein said information exchange means are adapted to interrogate said remote server (4) via said telecommunications network on detection of a nearby output device (8) in order to receive information from said server (4) and retransmit it directly to said detected output device (8) (page 2, paragraphs [0022] and [0025]; page 3, paragraphs [0033] and [0038]).

Regarding claim 13, Vanluijt discloses a device according to claim 11, comprising means (22) for storing information in order to store information received from said remote server (4) and to retransmit it subsequently to an output device (8) detected nearby (page 3, paragraphs [0040]-[0041]).

Regarding claim 14, Vanluijt discloses a device according to claim 11, comprising means (25) for setting its operating parameters enabling a user and/or the remote server (4) to set parameters for retransmission of received information as a function of the identity of the detected output device (8) (page 2, paragraph [0026]).

Regarding claim 15, Vanluijt discloses a device according to claim 14, further comprising means (26) for selecting and/or converting received information in order to enable the retransmission of some or all of said information in a format suited to output on the detected output device (8) (page 3, paragraphs [0036]-[0037]).

Regarding claim 17, Vanluijt discloses a device according to claim 11, being adapted to exchange information with said output device (8) by means of a wireless radio connection (page 2, paragraph [0032]).

Regarding claim 18, Vanluijt discloses a device according to claim 17, exchanging information with said output device (8) in accordance with the "BLUETOOTH" protocol and said automatic means for detecting the presence of an output device nearby and said automatic information retransmission means take the form of a BLUETOOTH communications module (23) (page 2, paragraphs [0032] and [0038]-[0039]).

Regarding claim 19, Vanluijt discloses an information retransmission system (Fig. 1) comprising a device (2) (Fig. 1, reference numerals 120-122) for retransmitting information received from a remote server (4) (Fig. 1, reference numeral 101) over a telecommunications network (6) (Fig. 1, reference numeral 110; page 3, paragraph [0033]) in order to retransmit it to a output device (8) (Fig. 1, reference numeral 130; page 2, paragraph [0022]) comprising means for receiving information coming from said information retransmission device (page 5,

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paragraph [0056]) and means for output of that information (page 5, paragraph [0057]), wherein said information re-transmission device (2) is a device according to claim 11 (see rejection of claim 11, above).

Regarding claim 20, Vanluijt discloses a system according to claim 19, wherein said output device is an output device selected from the group comprising the following devices: mobile telephone (8a); a personal digital assistant (8b); a watch (8c); a television (8d); and a portable computer (8e) (Fig. 1, reference numeral 130).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vanluijt in view of Mumick et al. (hereinafter "Mumick"; Patent No.: 5,751,798).

Regarding claim 16, Vanluijt discloses a device according to claim 11 (see above). Vanluijt fails to disclose also being connected to at least one standard telephone device and comprises means (27) for identifying the addressee of an incoming call and means (28) for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device (10) and said information exchange means (21).

However, Vanluijt does disclose that the network may be a phone network (page 3, paragraph [0033]), which is notoriously well known in the art for its connection to at least one standard telephone device.

In addition, Mumick discloses also being connected to at least one standard telephone device and comprises means for identifying the addressee of an incoming call and means for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device and said information exchange means (Fig. 1; col. 4, lines 39-42).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to connect the device of Vanluijt to at least one standard telephone device and comprises means for identifying the addressee of an incoming call and means for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device and said information exchange means as suggested by Mumick.

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One of ordinary skill in this art would have been motivated to connect the device to at least one standard telephone device and comprises means for identifying the addressee of an incoming call and means for switching calls in order to enable the switching of incoming calls between said at least one standard telephone device and said information exchange means because it would perform call processing functions for the cellular phones and the receiving phones, e.g., handling the dialed numbers and connecting the call (Mumick: col. 3, lines 6-10).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Casais (WO 01/20844) discloses retransmitting electronic data from servers to mobile telephones via a wireless vending machine over a Bluetooth local network.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marivelisse Santiago-Cordero whose telephone number is (571) 272-7839. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


10/17/05
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